

## **COMMENTS**

This Amendment is submitted in response to the Office Action dated August 26, 2004, having a shortened statutory period set to expire November 26, 2004. In the present Amendment, Claims 1, 12, 16, 19, 20 and 31 are amended. Claims 1-52 are now pending.

Applicants appreciate the teleconference held with the Examiner on November 16, 2004. No agreement was reached during this teleconference.

### **Objection to the Drawings**

In paragraph 2 of the present Office Action, the Examiner has objected to Figure 4 for having incorrectly positioned logic answers ("NO" and "YES") coming from query block 450. Applicants appreciate this observation, and have attached a corrected sheet reflecting the proper logic answers positioning.

### **Objection to the Specification**

In paragraph 3 of the present Office Action, the Examiner has noted a typographical error on line 6 of page 4 ("ths" should be "the"). Again, Applicants appreciate the Examiner's eye for detail, and now submit a proposed correction herein.

### **Rejections under 35 U.S.C. § 112**

In paragraph 6 of the present Office Action, the Examiner has rejected Claims 1-11 and 20-27 under 35 U.S.C. § 112 for lack of antecedent for the term "the relationship." The present amendment presents an amended term "a relationship" in Claims 1 and 20 to overcome this rejection. Applicants thus respectfully traverse this rejection and request that it be withdrawn.

### **Rejections under 35 U.S.C. § 101**

In paragraph 8 of the present Office Action, the Examiner has rejected Claims 12-19 for claiming "non-functional descriptive material." In the present amendment, Applicants incorporate the feature of wherein said compatibility table includes a stepping level relationship code that identifies which stepping levels can replace or be replaced by said firmware image, from original Claim 19, thus providing the requisite functionality ("stepping levels can replace or

be replaced by said firmware image”). Applicants thus respectfully traverse this rejection and request that it be withdrawn.

### **Rejections Under 35 U.S.C. §§ 102 and 103**

In paragraph 10 of the present office action, the Examiner has rejected Claims 1-14, 17-29 and 32-52 under 35 U.S.C. § 102(b) as being anticipated by *Kathail* (U.S. Patent No. 5,802,365 – “*Kathail*”). In paragraph 12 of the present office action, the Examiner has rejected Claims 15-16 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over *Kathail* in view of Applicant’s Admitted Prior Art (AAPA). Applicants respectfully traverse these rejections, and request that they be withdrawn and all claims allowed.

*Kathail* describes a method for automatically correlating a device to its appropriate driver. If the device does not already have a driver, then a candidate list of drivers is provided. Each driver from the list is sequentially tried until a driver is found that does not cause an error. (*Kathail* abstract.) A device in a device tree is automatically matched up with its appropriate driver according to the device’s name (*Kathail*, col.7, lines 57-59). If the new device does not have a name, then a pseudo-name is made up for it (*Kathail*, col. 8, lines 19-22). A driver description for the driver then helps a device manager pick the best driver among multiple candidates (*Kathail*, col. 8, lines 64-66). Thus, replacing a driver is a simple two-step process of 1) the driver to be replaced giving up control of the device and 2) installing the new driver (*Kathail*, col. 17, lines 57-62). If two drivers are available, then the most recent version is chosen (*Kathail*, col. 36, lines 12-13). Thus, the device asks 1) is there a driver available and 2) where is the most current version of the driver (*Kathail*, col. 42, lines 45-47)?

With reference to exemplary Claim 1, *Kathail* does not teach or suggest “determining if said [two] firmware images are compatible.” *Kathail* never addresses the issue or whether two firmware images are compatible, but rather is focused only on whether a driver (firmware) is compatible with a hardware device.

Furthermore, *Kathail* assumes that all firmware updates (replacements) are compatible. For example, when replacing an original driver with an update replacement (as articulated in exemplary Claim 19 of the present invention), *Kathail* assumes that the update will work properly, as there is no suggestion by *Kathail* to make a determination as to whether the update will work (is compatible).

As the cited prior art does not teach or suggest all of the claims features in the presently presented claims, Applicants respectfully request that all pending claims be allowed.

### CONCLUSION

Applicants now respectfully request a Notice of Allowance for all pending claims.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 50-0563**.

Respectfully submitted,



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### **IN THE DRAWINGS**

Please replace Figure 4 with the attached "Replacement Sheet," showing the correct logical conditions from query block 450. No new matter is added.